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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,027	10/21/2003	Jon Muskin	Mus-01	4679

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EXAMINER
HARPER, TRAMAR YONG

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/689,027	MUSKIN, JON	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-37* is/are pending in the application.

4a) Of the above claim(s) *1-34 and 38-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/28/07, 4/21/04, 10/21/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group 1, Species 2 Claims 35-37 in the reply filed on 12/26/07 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In regards to claim 36, Examiner fails to interpret where in the specification including original claims is "wherein the sum of the secondary payouts multiplied by each secondary payout's respective probability of occurring after the draw based on the held cards and discards is a predetermined number" disclosed. In regards to claim 37, Examiner fails to interpret where in the specification including original claims is "wherein if the held cards comprise a winning rank on the first pay table, then a secondary award for the winning rank is automatically deactivated on the second pay table" is disclosed. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 3 of U.S. Patent No. 7,017,909. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are drawn to providing a first payout for a first wager including a first pay table based on the final hand of cards of draw poker and providing a second pay table based on the drawn cards, wherein the second pay table awards are awarded based on the final hand and a second wager. A similar invention/method is disclosed in the instant application, but further including updating the second pay table based on probabilities of obtaining winning hand based on the held and discarded cards. The instant claims are narrower than the patent claims, but

include the limitations of the broader patented claims e.g. the patented claims are encompassed in the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awada (US 6,206,780) in view of Luciano (US 6,368,214) in further view of Jarvis (US 7,201,654).

Claim 35: Awada discloses a video poker machine, wherein a player inserts or provides a wager and the machine displays an initial five card stud poker hand. The machine then displays a first payout table for a first payout based on the initial hand and provides a payout based on the initial hand. The machine provides the player the opportunity to hold and discard cards of the initial. In response to the exchange or replacement of cards a modified second payout table is displayed and the player in awarded an additional award based on the final hand. The awards of the second pay table are lower the awards of the respective hands of the first pay table. It is well known in the art that ranks with lower probabilities of occurring have higher award payouts than ranks with higher probabilities of occurring. As such, the drawings illustrate such a limitation (Abstract, Col. 3:4-66, Figs. 1-3).

Awada excludes displaying a second pay table, wherein the awards are updated based on the held cards and discards, each secondary award reflecting respective probabilities of forming respective rank on a draw based on the held cards And the discards, wherein the awards are sorted from highest to lowest then their respective probabilities to form respective ranks on the draw using the held cards and discards are in order from lowest to highest. However, Luciano discloses a keno wagering game that is based upon a multi-step game. The game comprises a dynamic pay table, wherein the starting values or payouts (one out of one, two out of two, etc.) are based on the number of numbers selected by the player. As the game progresses the values change offering lower prizes because the probability of drawing a ball that matches one of the selected numbers increases. Higher prizes correspond to prizes with lower probabilities of occurring and vice-versa. This is interpreted as awards changing based probabilities respective of the selected player numbers and already drawn numbers from a set of numbers. Figs. 6B-6D (6B zero balls drawn, 6D two drawn) illustrates how the award pay table changes based on the probabilities of the player achieving matches. Fig. 6B illustrates a first pay table based on no drawn balls. Fig. 6C illustrates the pay out table with lower award values based on one drawn ball. Luciano discloses that the above game method can be applied to video poker, solitaire, blackjack, etc (Abstract, Col. 8:27-Col. 9:29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the video poker game of Awada with the updated probability award payout table of Luciano to provide a more defined payout that provides various payouts to the player without as much of a loss to the house based on

varying probabilities. It would be a disadvantage to the house to award larger payouts with an increase in probability of achieving winning outcomes. Such a modification, adds a heightened level of interactivity because a player can use the updated payout table to maximize winnings and minimize losses e.g. add to player strategy and the house/casino/establishment can minimize the loss to the house and still provide awards to the player.

Awada in view of Luciano excludes the first award from the first pay table for a particular rank is higher than a second award from the first pay table for a specific rank while a secondary award from the second pay table for the particular rank is lower than a secondary award from the second pay table for the specific rank. However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage. One of ordinary skill in the art furthermore, would have expected the first and dynamic second payout tables of Awada in view of Luciano, and applicant's invention, to perform equally well with either the first and second payout tables (second table including adjusted payout based on probabilities) as taught by Awada in view of Luciano, or the claimed a first award from the first pay table for a particular rank is higher than a second award from the first pay table for a specific rank while a secondary award from the second pay table for the particular rank is lower than a secondary award from the second pay table for the specific rank because both provide the same function of providing a first and second payout table, and more specifically a second payout table with adjusted awards based on increasing or higher probabilities of achieving winning outcomes. Therefore, it would have been prima facie obvious to modify Awada

in view of Luciano to obtain the invention with respect to claims 35 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano.

Awada in view of Luciano further excludes paying the first wager using the first pay table based on the final hand and paying a second wager made by the player before the draw using the second pay table based on the final hand. It is well known in the art to settle a first and second wager on a final hand. Jarvis discloses a poker game with a secondary bet option. The player places a first wager on a final hand against a first payout table, and before the draw is allowed to place a second wager on a final hand against a specific winning hand (Abstract, Col. 4:1-11). It would have been obvious to one of ordinary skill at the time of the invention to modify the video poker gaming machine of Awada in view of Luciano with the second wager aspect of Jarvis to provide more incentive to the gaming establishment. Such a modification, increases the amount waged in a given gambling period e.g. increases the casino income per hour of gambling (Col. 4:1-11).

Claim 36: Awada in view of Luciano in further view of Jarvis discloses the above with respect to Claim 35, but excludes wherein the sum of the secondary payouts multiplied by each secondary payout's respective probability of occurring after the draw based on the held cards and discards is a predetermined number. However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage. One of ordinary skill in the art furthermore, would have expected the secondary payouts of Awada in view of Luciano in further view of Jarvis, and applicant's invention, to

perform equally well with either the secondary payouts based on increased probabilities or probabilities of occurring as taught by Awada in view of Luciano in further view of Jarvis, or the claimed wherein the sum of the secondary payouts multiplied by each secondary payout's respective probability of occurring after the draw based on the held cards and discards is a predetermined number because both provide the same function of providing secondary adjusted awards based on increasing or higher probabilities of the player achieving various winning outcomes. Therefore, it would have been prima facie obvious to modify Awada in view of Luciano in further view of Jarvis to obtain the invention with respect to claims 36 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano in further view of Jarvis.

Claim 37: Awada in view of Luciano in further view of Jarvis discloses the above with respect to Claim 35, but excludes wherein if the held cards comprise a winning rank on the first pay table, then a secondary award for the winning rank is automatically deactivated on the second pay table. However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage. One of ordinary skill in the art furthermore, would have expected the payouts of the first and second pay tables of Awada in view of Luciano in further view of Jarvis, and applicant's invention, to perform equally well with either available payouts indicated on the first and second payout tables of Awada in view of Luciano in further view of Jarvis, or the claimed wherein if the held cards comprise a winning rank on the first pay table, then a secondary award for the winning rank is automatically deactivated on the second pay

table because both provide the same function of providing payouts to a player based on a first and second wager of a final hand. Therefore, it would have been prima facie obvious to modify Awada in view of Luciano in further view of Jarvis to obtain the invention with respect to claims 37 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano in further view of Jarvis.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shackleford (US 2005/0059451) discloses adjusting a pay table based on the held and discard cards of multiple draws.

Slomiany (US 7,294,058) discloses gaming machines evaluating optimum award scenarios.

Charron (US 5,542,669) discloses adjusting pay tables based on increasing payback percentages.

deKeller (US 2003/0017867) discloses adjusting pay tables based on probabilities.

Lemay (US 6,802,778) discloses reconfigurable pay tables.

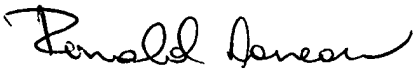
Wood (US 5,401,023) teaches variable awards wagering system that displays the possible awards based on player selected strategies.

Schultz (US 5,294,120) teaches updated pay tables based on held and discarded cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau
Primary Patent Examiner
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TH

01/22/08